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OFFICE OF PETITIONS

In re Application of :
Semba et al. : DECISION ON REQUEST FOR
Application No. 09/870,821 : RECONSIDERATION OF
Filed: June 1, 2001 : DISMISSAL OF APPLICATION FOR
Attorney Docket No. 04853.0073 : PATENT TERM ADJUSTMENT-PRE-GRANT
: FURTHER APPLICATION FOR
: PATENT TERM ADJUSTMENT-PRE-GRANT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF DISMISSAL OF APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT AND FURTHER APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT," filed September 8, 2005. In part, applicants request reconsideration of the decision dismissing application for patent term adjustment mailed April 11, 2005. Given the request for reconsideration of dismissal, and in light of a second application for patent term adjustment based on the determination of patent term adjustment under 35 U.S.C. 154(b) shown in the second notice of allowance mailed June 8, 2005, applicants request that the initial determination of patent term adjustment be corrected from zero (0) days to ninety-three (93) days.

To the extent that the instant application for patent term adjustment requests reconsideration of the decision dismissing application for patent term adjustment mailed April 11, 2005, the application is **DISMISSED AS UNTIMELY FILED.**

37 CFR 1.181(f) provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action

complained of may be dismissed as untimely. The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided. A number of sections (e.g., 37 CFR 1.377, 37 CFR 1.378, 37 CFR 1.644, and 37 CFR 1.740) specify the time period within which a petition must be filed (or may be dismissed as untimely). The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed. The 2-month period is not extendible under 37 CFR 1.136(a) since the time is within the discretion of the Director of the USPTO. See MPEP 1002.

There is no provision in the rules for requesting before the Office reconsideration of decisions on application for patent term adjustment under § 1.705(b). Accordingly, 37 CFR 1.181(f) applies, and the period for requesting reconsideration of a decision on application for patent term adjustment is a non-extendable two month time limit. Thus, it is appropriate to dismiss the instant request for reconsideration filed on September 8, 2005, almost 5 months after the decision mailed April 11, 2005, as untimely filed.

As to the second application for patent term adjustment, the application is GRANTED to the extent indicated herein.

On June 8, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On September 8, 2005, applicants timely submitted the instant application for patent term adjustment¹. Applicants contend that a reduction of 133 days associated with their filing of an Information Disclosure Statement (IDS), a Petition for Withdrawal from Issue and a Request for Continued Examination (RCE) on April 12, 2005 is incorrect. Applicants acknowledge that the filing of the IDS did not occur within the 30 days of receipt under § 1.704(d). Nonetheless, applicants contend that no reduction is warranted because this submission is not within the proscribed "circumstances that constitute a failure of applicant to engage in reasonable efforts to conclude prosecution" under 1.704(c).

¹ PALM records show that in response to the 2nd Notice of Allowance, the Issue Fee was received on September 8, 2005.

Yet, in the alternatively, applicants assert that if treated as a reduction pursuant to 1.704(c)(10), the reduction of 133 days is incorrect. Applicants acknowledge that the reduction should then be 57 days, counting the number of days beginning on April 12, 2005, to and ending on June 8, 2005, the date of mailing of the second Notice of Allowance.

Applicants state that the above-identified application is not subject to a terminal disclaimer.

Applicants arguments have been considered. Applicants are advised that 37 CFR 1.704(c)(1) through 1.704(c)(11) address situations that occur with sufficient frequency to warrant being specifically provided for in the rules of practice. These situations do not represent an exhaustive listing of actions or inactions that interfere with the Office's ability to process or examine an application, since there are a myriad of actions or inactions that occur infrequently but will interfere with the Office's ability to process or examine an application (e.g., applicant files and persists in requesting reconsideration of a meritless petition under 37 CFR 1.10; parties to an interference obtain an extension for purposes of settlement negotiations which do not result in settlement of the interference; and when the scope of the broadest claim in the application at the time an application is placed in condition for allowance is substantially the same as suggested or allowed by the examiner more than six months earlier than the date the application was placed in condition for allowance). Thus, the actions or inactions set forth in 37 CFR 1.704(c) are exemplary circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The Office may also reduce a period of adjustment provided in 37 CFR 1.703 on the basis of conduct that interferes with the Office's ability to process or examine an application under the authority provided in 35 U.S.C. (b)(2)(C)(iii), even if such conduct is not specifically addressed in 37 CFR 1.704(c).

In this instance, it appears that the reduction of 133 days was entered pursuant to § 1.704(b). This is incorrect. Nonetheless, a reduction pursuant to § 1.704(c)(10) of 58 days (not 57 days) is proper. As acknowledged by applicants, the relevant papers were filed after the mailing of a notice of allowance, did not include a 1.704(d) statement, and were responded to with the mailing of a second Notice of Allowance. By definition, this is a failure to engage in reasonable efforts to conclude prosecution within the

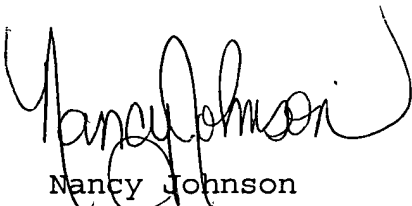
meaning of 1.704(c)(10). Fifty-eight (not 57) days is the number of days in the period, counting the number of days beginning on April 12, 2005 and ending on June 8, 2005.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance mailed June 8, 2005 is zero (0) days (including two hundred fifty-nine (259) days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 06-0916, as authorized. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, sweeping flourish extending from the end of the name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions